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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,000	04/26/2001	Frank Charles Pagano	Rev 98-25	7885

26807 7590 06/19/2009

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EXAMINER	
PURDY, KYLE A	
ART UNIT	**PAPER NUMBER**
1611	

MAIL DATE	DELIVERY MODE
06/19/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/843,000	PAGANO ET AL.	
	Examiner	Art Unit	
	Kyle Purdy	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02/03/2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *61,64,66,68 and 81-88* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *61,64,66,68 and 81-88* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of t/e previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/07/2009 has been entered.

Status of Application

2. The Examiner acknowledges receipt of the arguments filed on 02/03/2009.

3. Claims 61, 64, 66, 68 and 81-88 are presented for examination on the merits. The following rejections are made.

Response to Amendment

4. The declaration under 37 CFR 1.132 filed 02/03/2009 is insufficient to overcome the rejection of claims 61, 64, 66, 68 and 81-88 based upon Strella (US 3928656) in view of Ohno (US 5854365) and Perronin et al. (US 3991007), evidenced by US 5798426 as set forth in the last Office action.

5. Applicants declaration is directed to preparing Example 8 of Strella with Revlons Solvent Composition which comprises ethyl acetate, butyl acetate, acrylates copolymer, dipropylene glycol dibenzoate, methoxyisopropanol, isopropyl alcohol, nitrocellulose, stearalkonium netonite, benzophenone-1, PPG-2 dimethicone, citric acid, malic acid, acetyl tributyl citrate, tribenzoin and phosphoric acid. The declaration shows that this composition has water-resistant properties that the composition of Strellas' Example 8.

6. It should be pointed out that the instant claims only require a film forming polymer consisting of acrylic acid and butylmethacrylate, a non-aqueous solvent such as isopropanol or ethyl acetate and butyl acetate and pigments such as iron oxides and titanium dioxide. It should also be pointed out that the rejection does not rely solely on Example 8 of Strella.

7. All of these ingredients are suggested by the cited references, and one of ordinary skill would have been motivated to combine them to arrive at the presently claimed invention.

8. Strella specifically discloses using said copolymer in a pigmented composition at the required weight ratio at the required weight percentage relative to the composition. Strella teaches making a pigment composition comprising an ionic polymer consisting of acrylic acid and butyl methacryalte (5.8/94.2) and a pigment in a solvent. The solvents taught by Strella which are suitable for solubilizing the polymer include THF and isopropanol. Ohno is directed to a pigmented composition wherein the pigments include iron oxides among various other pigments. Perronin teaches a pigment composition comprising a film forming copolymer consisting of acrylic acid and esters of methacrylic acid such as butylmethacrylic acid in a non-aqueous solution with a pigment such as iron oxides and titanium dioxides. Solvents include isopropanol and various esters such as ethyl acetate and propyl acetate. Thus, all of the elements of Applicants invention are disclosed by each of the cited references, and because each of the references are within the same field of endeavor, an ordinary skilled person would have had sufficient motivation to combine each and arrive at the presently claimed invention with a reasonable expectation for success.

Response to Applicants' Arguments

9. Applicants arguments filed 02/23/2009 regarding the rejection of claims 61, 64, 66, 68 and 81-88 made by the Examiner under 35 USC 103(a) Strella (US 3928656) in view of Ohno (US 5854365) and Perronin et al. (US 3991007), evidenced by US 5798426 have been fully considered but they are not found persuasive.

10. The rejection of claims 61, 64, 66, 68 and 81-88 made by the examiner under 35 USC 103(a) is **MAINTAINED** for the reasons of record in the office action mailed on 11/25/2008.

11. In regards to the 103(a) rejection, Applicant asserts the following:

A) The pigments of Strella are not intended for use in cosmetics; and

B) Nitrocellulose is incompatible in alkaline or neutral.

12. In response to A, Applicants showing that the Cabot Corporation does not sell Carbon Black pigments is not persuasive. First, there is no substantive reason as to why the pigment is not sold into the market. Second, this is just one pigment out of the many exemplified by the references. Even assuming that carbon black pigments were not suitable for use is cosmetic compositions, there are many other taught pigments that meet the limitations of the present claims. Applicants argument is not found persuasive.

13. With respect to B, the Examiner acknowledges that nitrocellulose decomposes in alkaline environments. However, it's not clear why the compositions formed by the references would have a neutral/alkaline pH. None of the references teach a preferred pH for their composition. Additionally, as the formed composition would only comprise a solvent, a polymer, nitrocellulose and a pigment, identical to that as claimed, there is no reason to believe the pH

would be any greater than neutral, especially in view of the inclusion of the acidic polymer (acrylic acid). Applicants argument is not found persuasive.

Maintained Rejections, of Record
Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. **Claims 61, 64, 66, 68 and 81-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strella et al (3,928,656; of record) in view of Ohno (5854365; of record) in view of Perronin et al (3,991,007; of record) as evidenced by US 5,798,426 (of record).**

16. Strella discloses a method of developing electrostatic latent images with pressure sensitive toner. The toner comprises 19 parts of an ionic polymer (15.8%), 100 parts of tetrahydrofuran (ether solvent-83.3%), and 1 part Mogul black (pigment- 0.8%) (see example 1 and preparation of toner, column 9; see instant claim 61, 64 and 66). The ionic polymer disclosed is butyl methacrylate-acrylic copolymer (94.2/5.8) with a TG of 46 degrees Celsius (see examples II and VIII; see instant claim 61). Strella teaches the use of a pigment or dye such as carbon black, a commercial red, blue, or yellow dye, or any other well-known pigment in an amount of 1-20% (see column 6, lines 4-16; see instant claim 87).

17. Although Strella teaches pigments in the composition, the instant pigments are not specified. Further, the instant solvents and the inclusion of nitrocellulose are not taught.

18. Ohno teaches a toner composition wherein the pigment may be carbon black, an aniline black, acetylene black, naphthol yellow, Hansa yellow, rhodamine lake, alizarin lake, iron oxide red, phthalocyanine blue and indanthrene blue in the amount of 0.1-20% (see column 22, lines 25-40; see instant claim 61 and 87).

19. Perronin teaches the preparation of pigmentary particles coated with an organic polymer to allow dispersion of the pigment in a medium. Perronin discusses the importance of pigments in many fields such as textiles, plastics, inks, textiles, and cosmetics (see column 1, lines 10-12). Perronin teaches the pigment compositions may be advantageously used in numerous fields of application, such as inks, plastics materials, paints, or other colored preparations (see column 4, lines 45-55). Perronin teaches examples of monomers which may be used in the process include 1) alkene-mono- or di-carboxylic acids, preferably the acids containing up to five carbon atoms, for example acrylic, methacrylic, etc.; 2) esters of these acids, such as methyl, ethyl, butyl, etc. (see column 3, lines 40-60; see instant claim 61). Perronin teaches the pigments used in the composition may be iron oxides and titanium dioxide (see column 2, line 65 to column 3, line 5; see instant claim 61). The solvents may be selected from gasolines, aromatic hydrocarbons such as benzene, toluene, xylene, halogenated hydrocarbons such as trichloroethylene, perchloroethylene, chlorobenzene, trichlorobenzene, chlorofluoromethanes, chlorofluoroethanes, alcohols such as methanol, ethanol, n-propanol, l-methyl-ethanol, n-butanol, 2-methyl-propanol, 1,1-dimethyl-ethanol, ketones such as 2-propanone, 2-butanone, 4-methyl-2-pentanone, esters such as ethyl acetate, propyl acetate, 1-methyl-ethyl acetate, ethers such as diethyl ether, ethylpropyl ether, tetrahydrofuran, and 1,4-dioxan (see column 2, lines 45-61; see instant claim 61).

20. Example 6 provides a composition (composition D) with 100 parts a pigment, 350 parts heptane, 90 parts methyl methacrylate, and 10 parts acrylic acid. 190 parts of composition D is then combined with 86 parts of 50% nitrocellulose resin in butyl acetate, 210 parts ethyl acetate (ester solvent), 22 parts butanol, 155 parts isopropanol, and 28 parts butyl phthalate (plasticizer). Note that in composition of Example 6, nitrocellulose comprises about 1.0 % by weight of the total composition (math not shown; see instant claims 81 and 82). It is taught that nitrocellulose enhances the coloristic development of the pigmented ink (see column 7, line 55).

21. US 5,798,426 discloses BMA/AA (90/10) has a weight of 69,400 (see instant claims 83 and 84).

22. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Strella, Ohno, and Perronin and substitute tetrahydrofuran with the claimed solvents such as isopropanol, ethyl acetate and so on. One would have been motivated to do so since Perronin teaches tetrahydrofuran and the claimed solvents are utilized as the organic solvents for the copolymers. Regarding the inclusion of the instantly claimed pigments, because they are obvious. Ohno and Perronin both teach pigments for use in compositions comprising polymers. With regard to claims 81 and 82, Perronin teaches including about 1.0% of nitrocellulose in their composition which obviates the instantly claimed ranges. One would have been motivated to include nitrocellulose into the pigmented composition in order to enhance the coloristic development of the final formulation. With regard to the functional limitations (i.e. a nail enamel) of the instant claims, it is the position of the Examiner that Strellas and Perronin's composition is capable of leaving a water-insoluble film on the nail since the compositions are substantially similar. With regard to the copolymers molecular

weight, the Examiner cites US 5,798,426 as art of interest wherein '426 states that BMA/AA (90/10) has a weight of 69,400, which reads on about 68,000. Therefore, a composition comprising a solvent, a pigment, a copolymer of butyl methacrylate-acrylic acid is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kyle Purdy/
Examiner, Art Unit 1611
June 18, 2009

/David J Blanchard/
Primary Examiner, Art Unit 1643